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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/550,306	04/14/2000	Ted Richards	6057/61524	9131

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EXAMINER

OUELLETTE, JONATHAN P

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 08/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/550,306

Applicant(s)

RICHARDS, TED

Examiner

Jonathan Ouellette

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Claims 1-4, 10-13, and 19-21 have been amended. Claims 1-21 are currently pending in application 09/550,306.

Claim Rejections - 35 USC § 112

2. The rejection of Claim 21 under 35 U.S.C. 112, second paragraph, is withdrawn due to applicant's amendment.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claims 1, 3, 10, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Kurtzman, II et al (US 6,144,944).**
5. As per independent Claims 1 and 10, Kurtzman discloses a method (system) of responding to a request, the method (system) comprising the steps of: establishing a plurality of categories of potential requests; associating a plurality of sets of data with each of the categories (ad exec program – affinity engines) (C3 L57-60); and in response to receipt of a request, assigning the request to one of the categories based on a subject

matter in the data requested, relating one of the categories to the request and preparing a response including at least two sets of data (advertisements) from the related category, said response including at least that data requested by the request (abstract, C3 L57-60, C4 L41-49).

6. As per independent Claims 3 and 12, Kurtzman discloses a method (system) of responding to a request, the method (system) comprising the steps of: establishing a plurality of categories of potential requests; associating a plurality of sets of data with each of the categories (ad exec program – affinity engines) (C3 L57-60); archiving successive requests from a given requester; and in response to receipt of a new request from the same requester, assigning the request to one of the categories based on a subject matter in the data requested, relating one of the categories to an archived request and the same or a different category to the new request according to the assignment of the new request, and preparing a response including at least two sets of data (advertisements) from at least one related category or at least one set of data from each of at least two related categories (abstract, C3 L57-60, C4 L41-49).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 2, 5-7, 9, 11, 14-16, and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kurtzman in view of Broadcast.com (www.broadcast.com, retrieved from Internet Archive Wayback Machine <www.archive.org>, page range: 12/1/1998-12/7/1998).**
9. As per Claims 2 and 11, Kurtzman fails to expressly disclose wherein said categories are selected from the group consisting of news, music and technology.
10. Broadcast.com discloses wherein said categories are selected from the group consisting of news, music and technology (www.broadcast.com).
11. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included wherein said categories are selected from the group consisting of news, music and technology, as disclosed by Broadcast.com in the system disclosed by Kurtzman, for the advantage of providing a method (system) of responding to a request, with the ability to increase customer service by supplying a variety of available information to choose.
12. As per Claim 19, Kurtzman and Broadcast.com discloses wherein said news is selected from the group consisting of political news, economic news, and cultural and social news (www.broadcast.com).
13. As per Claim 20, Kurtzman and Broadcast.com disclose wherein: said political news is selected from the group consisting of domestic political news and foreign political news; said economic news is selected from the group consisting of domestic economic news and foreign economic news; and said social and cultural news is selected from the group consisting of local events and developments, national events and developments, foreign

events and developments, the arts, and entertainment, and wherein: said music is selected from the group consisting of current popular music, older popular music, semi classical music, and classical music; and said technology is selected from the group consisting of telecommunication; electronics and related technologies; space exploration and colonization; manufacturing and operations; transportation and automotive vehicles; chemical technology; and biotechnology (www.broadcast.com).

14. As per independent Claims 5 and 14, Kurtzman discloses a method (system) of providing user information related to a user's selection, the method comprising the steps of: receiving a user's selection and an indicium identifying the user; analyzing the user's present selection and previous selections, if any, and identifying at least one user interest category based on the user's present and previous selections; selecting at least one user information item from the at least one identified user interest category; associating or combining the at least one user information item (advertising) with the user's selection; and delivering the associated or combined at least one user information item and the user's selection to the user over an electronic network (Abstract, Figs.2-5d, C2 L1-35, C4 L11-55, C5 L8-25, C6 L1-67, C7 L1-22, C11 L57-67, C12 L1-42, C13 L20-26, C15, L1-44, C17 L1-17, C18 L1-35).

15. Kurtzman fails to expressly disclose wherein the selection is audio data.

16. Broadcast.com discloses a method/system for selecting and obtaining audio data from the Internet (www.broadcast.com).

17. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included wherein the selection is audio data, as disclosed by

Broadcast.com in the system disclosed by Kurtzman, for the advantage of providing a method (system) of responding to a request, with the ability to increase customer service by supplying a variety of available information formats (audio and video) to choose.

18. As per Claims 6 and 15, Kurtzman and Broadcast.com disclose wherein said step of analyzing and identifying comprises the steps of: assigning each of said user's present audio data selections and said user's previous audio data selections to said at least one user interest category, and counting the number of assignments to each of said at least one user interest category; and when the accumulated number of assignments to a selected one of said at least one user interest category is greater than a selected threshold number, identifying the selected one of said at least one user interest category as a category from which said at least one user information item is selected.
19. As per Claims 7 and 16, Kurtzman and Broadcast.com disclose wherein the step of analyzing and identifying comprises the steps of: assigning each of said user's present audio data selections and said user's previous audio data selections to said at least one user interest category, assigning each of said user's present audio data selections and each of said user's previous audio data selections an approximate time at which said audio data selection was received, assigning each of said audio data selections a weighting factor that decreases as the difference between a present time and the approximate time at which said audio data selection was received, multiplying the numerical value of an assignment to each of said at least one user interest category by corresponding weighting factor to produce a numerical value for a weighted assignment to each of said at least one user interest category, and counting the numerical value of the weighted assignment to each of

said at least one user interest category; and when the accumulated number of weighted assignments to a selected one of said at least one user interest category is greater than a selected threshold number, identifying the selected one of said at least one user interest category as a category from which said at least one user information item is selected.

20. As per Claims 9 and 18, Kurtzman and Broadcast.com disclose selecting said at least one user information item to be an advertisement of at least one product that is related to said at least one user interest category.

21. Claims 4 and 13 are rejected under 35 U.S.C. 103 as being unpatentable over Kurtzman.

22. As per Claims 4 and 13, Kurtzman does not expressly show wherein said categories are selected from the group consisting of news, music and technology.

23. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The method (system) of responding to a request would be performed regardless of what category was selected. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

24. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have presented the user with a selection of categories consisting of news, music and technology, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

25. Claims 8, 17, and 21 are rejected under 35 U.S.C. 103 as being unpatentable over Kurtzman in view of Broadcast.com.

26. As per Claims 8 and 17, Kurtzman and Broadcast.com fail to expressly show choosing said at least one user interest category from the group of categories consisting of political news, economic news, cultural new, social news, technology news and music.

27. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The method (system) of responding to a request would be performed regardless of what interest category was selected. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

28. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have presented the user with a selection of interest categories consisting of political news, economic news, cultural new, social news, technology news and music, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

29. As per Claim 21, as understood by the examiner, Kurtzman and Broadcast.com fail to expressly show wherein said classical music is selected from the group consisting of pre-baroque music, baroque music, romantic music, modern music, operas, operettas, lieder and ballet and other dance music.

30. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The method (system) of responding to a request would be performed regardless of what type of classical music was selected. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).
31. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have presented the user with a selection of classical consisting of pre-baroque music, baroque music, romantic music, modern music, operas, operettas, lieder and ballet and other dance music, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Response to Arguments

32. Applicant's arguments received 4/9/2004, with respect to Claims 1-21 have been considered but are moot in view of the new ground(s) of rejection.
33. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
34. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Conclusion

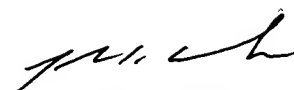
35. Additional Patent Literature has been referenced on the attached PTO-892 form, and the Examiner suggests the applicant review these documents before submitting any amendments.
36. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (703) 605-0662. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.
37. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-3597 for After Final communications.
38. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5484.

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August 25, 2004


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